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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/648,009

08/25/2003

Amlan Datta

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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

03/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/648,009	Applicant(s) DATTA ET AL.	
	Examiner Paul Marcantoni	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date | 6) <input type="checkbox"/> Other: _____ |

2/7/08, 5/17/05, 5/25/07, 7/21/04, 8/28/06, 9/2/05, 12/11/03, 2/7/08.

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Applicant's arguments filed 2/7/08 have been fully considered but they are not persuasive.

New Matter:

The new matter has been withdrawn as applicants inserted –58.9 wt% (for silicon dioxide or silica) in place of “59 wt%”.

Provisional ODP:

The Provisional ODP has been withdrawn in light of applicants' comments. No other pending related application has yet been allowed.

35 USC 102/103:

Claims 1,5,6 and 12-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Beck et al. (3M Patent-US Patent No. 3,365,315-also listed on page 11 of paragraph [0038] of applicants' specification).

Response:

Goetz et al. '550 Withdrawn:

Goetz et al. has been withdrawn because applicants amended their range of alumina from 6 to 40 wt% to **12.8** to 40 wt%. The maximum upper limit for alumina amount is 10 wt% for Goetz and Goetz also does not teach this range is an *approximate* range or use the term *about*. Goetz was thus withdrawn from the rejection.

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Beck et al. '315:

Beck still remains. This represents the US Patent of their potential competitor 3M, (or Minnesota Mining and Manufacturing) who make many similar products such as glass microspheres. The applicants argue that Beck does not teach their range of silica of about 30 wt% to not more than 58.9 wt%. The previous stated italicized range which is claimed by applicants in claim 1 can also be written:

"about 30 wt% to not more than about 58.9 wt%." In other words, *about 1* and 2 is the same as *about 1 to about 2*. Thus, "about" permits some tolerance. It is the examiner's position that applicants "about 58.9 wt%" is 60 wt% (claimed by Beck). "About" permits some tolerance. At least about 10% was held to be anticipated by a teaching of a content not to exceed about 8%. In re Ayers, 154 F 2d 182, 69 USPQ 109 (CCPA 1946). A pressure limitation of 2-15 PSI was held to be readable on a reference which taught a pressure "of the order of about 15 PSI." In re Erickson, 343 F 2d 778, 145 USPQ 207 (CCPA 1965).

Also, Beck teaches in column 4, lines 24-25 (before Table I teaching glass particle composition including silica range of 60-80 wt%) that Table I represents a preferred composition. A reference is good for all that it realistically teaches and is not limited to the preferred amounts in its disclosure. Note that Beck even teaches the amount of silica is preferably at least about 40 wt% (col.3, lines 54-56). Thus, it is evident Beck does not limit his invention to greater than or equal to 60 wt% silica contrary to applicants' assertions. Further, the examiner is not limiting himself or Beck either by saying that 60 wt% is the minimum. The fact

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that Beck teaches at least about 40 wt% silica shows that certainly 60 wt% silica is not the minimum amount of silica usable in Beck's glass composition.

Also, applicants are referred to column 4, lines 22-25 wherein Beck not only teaches Table I not only represents a preferred composition but that the amounts presented are approximate ranges. Approximate means the same as about. Again, about permits some tolerance. At least about 10% was held to be anticipated by a teaching of a content not to exceed about 8%. In re Ayers, 154 F 2d 182, 69 USPQ 109 (CCPA 1946). A pressure limitation of 2-15 PSI was held to be readable on a reference which taught a pressure "of the order of about 15 PSI." In re Erickson, 343 F 2d 778, 145 USPQ 207 (CCPA 1965). Thus, since about and approximate mean the same, then the minimum limit for Beck for silica of 60 wt% is really "about 60 wt% silica" or "approximately 60 wt% silica". The applicants' upper limit of 58.9 wt% silica is "about" or "approximately" 60 wt% silica and thus Beck's glass composition still meets applicants' claims (e.g. see applicants' claim 1).

The examiner has addressed all applicants' remarks and finality is proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Marcantoni/
Primary Examiner, Art Unit 1793